

Docket No. 54172/4913

connected in series between a ground reference source and the coaxial cable outer shield. The '707 patent discloses a coaxial cable shield filter comprising a housing, input and output connectors 24, 26 secured to the housing, a coaxial conductor 12 within the housing and extending between the input and output connectors. The conductor 12 is wrapped around two iron toroids to form chokes 16, 18 which function as inductors connected in series with the coaxial conductor shielding. The Office asserts that the housing shown in the '707 patent inherently is grounded and thus serves as a ground reference source. An element of a claim is not "inherent" in a prior art reference unless the missing descriptive matter is "necessarily present in the thing described in the reference." *In re Robertson*, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999).

As stated by the Federal Circuit:

"Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

In re Robertson, 49 USPQ2d at 1951. Thus, in order for a rejection based on inherency to be proper, the housing shown in the '707 patent must necessarily serve as a ground reference source. For at least several reasons, the '707 patent's housing does not inherently act as a ground reference source.

First, there is no disclosure that the housing is even made of a conductive material. If the housing is made of plastic or some other nonconductive material, it cannot act as a ground source. Nothing in the '707 patent indicates that the housing is not made of a nonconductive material. In other words, nothing in the '707 patent indicates that the housing is necessarily of a conductive material. Because the '707

Docket No. 54172/4913

patent's housing is not necessarily a conductive material, it does not necessarily act as a ground source.

Also, the coaxial cable shield filter of the '707 patent could not operate if the housing were of a conductive material. Referring to Fig. 2 of the '707 patent, if the housing were of a conductive material, then the housing would conduct current directly from the input connector to the output connector and bypass the filter. Bypassing the filter would negate any utility of the filter. Thus, one of skill in the art would understand the '707 patent's housing to be made of a nonconductive material. For this additional reason the housing of the '707 patent does not necessarily act as a ground. In fact, the housing of the '707 patent cannot act as a conductor or as a ground without negating the filter. Thus, the inherency rejection of claim 13 should be withdrawn.

Claims 14 and 15 depend from claim 13 and are therefore not anticipated by the '707 patent for the same reasons claim 13 is not anticipated.

Claim 17 is not made obvious by the combination of the '707 patent and Fawal U.S. Patent 6,049,258 ("the '258 patent"). Claim 17 depends from independent claim 13. The '707 patent and the '258 patent, whether considered together or apart, fail to disclose or suggest the requirements of claim 13. The Office has acknowledged that the '707 patent does not specifically disclose the requirements of claim 13. Instead, the Office has taken the position that the requirements of claim 13 are inherently present in the filter disclosed in the '707 patent. For the reasons discussed above, the requirements of claim 13 are not inherently present in the filter disclosed in the '707

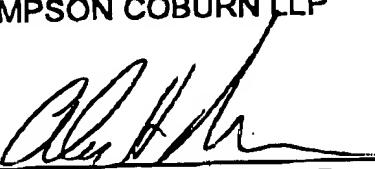
Do k t No. 54172/4913

patent. Also, inherency cannot be used as a basis for an obviousness rejection. Thus, the obviousness rejection of claim 17 should be withdrawn.

Respectfully submitted,

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September 19, 2002

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Docket No. 54172/4913

MARKED UP VERSION OF AMENDED CLAIMS

1 (twice amended). A filter for reducing RF interference on a coaxial network, the filter comprising:

a ferrite form; and

a [solid] grounding conductor having first and second ends, the conductor being wound about or through the ferrite form thereby creating a choke in series between the first conductor end and the second conductor end; and

a terminal coupler provided at one of the conductor ends for electrically coupling the choke between a coaxial network ground block and a ground reference source.

8 (twice amended). A filter for reducing impulse noise in a coaxial network wherein the impulse noise is being introduced into the coaxial network through a coaxial network ground wire, the filter comprising:

a ferrite form; and

a [solid] grounding conductor having first and second ends and a cross-section of sufficient size to function as a suitable ground for the coaxial network, the conductor being insulated from the ferrite form and wound about the ferrite form thereby creating an impulse noise choke.